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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,151	08/21/2001	Koichiro Kishima	SON-2198	6614

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EXAMINER

LESTER, EVELYN A

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/933,151

Applicant(s)

KISHIMA ET AL.

Examiner

Evelyn A. Lester

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,20 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 and 23-32 is/are allowed.
- 6) ☒ Claim(s) 1,6,20 and 22 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-28-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nomura et al (U.S. Patent 5,982,565).

Nomura et al discloses the claimed invention of an optical element having a “substrate” (i.e. the foundational material form) as noted in Figure 2 and its accompanying text, wherein there is a convex part (2) functioning as a convex lens, a flat part around the convex part (Figure 2), an outer circumference part (3) or flange, and wherein the thickness of the outer circumference part is greater than the convex part, therefore it is greater than the flat part and wherein the surface of the outer circumference part is flat or approximately flat (Figure 2).

With respect to the “whereby” statement at lines 7-8, while the features of an apparatus or product may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al (U.S. patent 5,982,565) in view of Lee et al (U.S. patent 5,665,957).

Nomura et al disclose the claimed invention of an optical element as described above, however, does not provide all the specific environment details, which this optical element is employed. Nomura et al do teach that the optical element is usable in optical recording systems and the like as noted in Figure 4 and its accompanying text, especially beginning at column 4, line 64, wherein Nomura et al describe the optical element mounted above a storage medium. However, Nomura et al are silent as to specifically reciting a photodetector. It is well known to one of ordinary skill in the art that such recording devices have photodetectors, as disclosed in Lee et al's invention. Since Lee et al clearly teach that providing a photodetector for an optical pickup or recording system is well known in the art for obtaining a focus error signal, for example, it would have been obvious to one of ordinary skill in the art that Nomura et al's employment of the optical element in an optical pickup system would have also included a photodetector to provide needed information relating to a focus error, for example.

***Allowable Subject Matter***

3. Claims 8-10 and 23-32 are considered to be in condition for allowance.
4. Claims 3-5 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. The following is a statement of reasons for the indication of allowable subject matter: For the reasons for allowance stated in the office action mailed on 3-1-04. New claims 24, 30 and 31 correspond to the subject matter of claims 3, 5 and 7, respectively, and are considered to be allowable for the same reasons.

***Response to Arguments***

6. Applicant's arguments filed 4-28-04 have been fully considered but they are not persuasive.

The Applicant's arguments directed to Nomura et al not disclosing the claimed limitation of the outer circumference part being greater than the convex part is not well received. Clearly in Nomura et al's Figure 2, the outer circumference part is greater than the convex part, as further explained in the rejection previously. Further, the "flat part" of Nomura et al is not that of the outer circumference part (3), but is the non-angled area (not labeled with a numeral) between the convex part and the outer circumference part.

Therefore, all of the claimed limitations are met by Nomura et al and the rejection is hereby maintained.

Please note that due to the amendment of claim 1 (e.g. incorporating the subject matter of original claim 2), the 102b rejection is not a new prior art rejection because the original rejection in the office action mailed on 3-1-04 rejected claims 1, 2 and 6.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-

2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm, subject to an increased flex-time schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn A. Lester  
Primary Examiner  
Art Unit 2873